

## REMARKS

Claims 9-16 were examined and stand rejected. In response, Applicant amends Claims 9 and 13. Applicant respectfully requests reconsideration of pending Claims 9-16, as amended, in view of at least the following remarks.

### **I. Claims Rejected Under 35 U.S.C. §102**

The Patent Office has rejected Claims 9, 13 and 16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,443,675 issued to Wensink ("Wensink"). Applicant respectfully traverses this rejection.

Applicant respectfully asserts that the Patent Office has failed to adequately set forth a *prima facie* rejection under 35 U.S.C. §102(b). "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik v. American Hoist & Derrick* ("Lindemann"), 730 F.2d 452, 1458 (Fed. Cir. 1994)(emphasis added). Additionally, each and every element of the claim must be exactly disclosed in the anticipatory reference. *Titanium Metals Corp. of American v. Banner* ("Banner Titanium"), 778 F.2d 775, 777 (Fed. Cir. 1985).

Claim 9, as amended, includes the following claim feature, which is neither taught nor suggested by Wensink, or the references of record:

receiving an IC package, bonded onto a printed circuit board via a surface mount attachment.

According to the Examiner, the decapsulation process of an IC taught by Wensink establishes an electrical connection within the integrated circuit to be tested where the attachment of the IC package to a connector board is a surface mount attachment. Applicants respectfully disagrees with the Examiner's contention.

The Examiner finds support for the assertion based on FIG. 1 of Wensink. As illustrated in FIG. 1, a DUT 22 includes J-type leads 28 that contact board 26 and, thus, bring out the electrical connections of DUT 22 outside machine 10. (Col. 4, lines 18-21) Furthermore, clamps 24, clamp DUT 22, connector board 26 and top plate 18 together into a fixed or assembly 30. (Col. 4, lines 21-23) In other words, as illustrated with reference to FIG. 1, the failure of Wensink to attach DUT 22 to connector board via a surface mount requires the use of clamps 24. Otherwise, DUT 22 would not be connected to connector board 26.

Applicant respectfully submits that after careful review of FIG. 1, as well as the specification of Wensink, DUT 22 is not bonded to connector board 26 via a surface mount

attachment. Namely, J-type leads 28 of DUT 22 are not bonded to connector board 26 in accordance with a traditional surface mount attachment. As is clearly illustrated in FIG. 1, clamps 24 provide the connection between J-type leads 28 of DUT 22 to connector board 26.

Accordingly, Applicant respectfully submits that Wensink fails to teach or suggest receiving of an integrated circuit package bonded onto a printed circuit board via a surface mount attachment, as required by Claim 9. As depicted in Wensink's FIG. 1, DUT 22 is simply temporarily connected to connector board 26 during decapsulation testing using clamps 24. Therefore, clamping of a DUT to a board during decapsulation testing does not teach or suggest testing of an IC package after the package is bonded onto a PCB via a surface mount attachment, as required by Claim 9.

To wit, the case law is very clear in requiring that each and every element of the claim must be exactly disclosed in the anticipatory reference. *Id.* Accordingly, Applicant respectfully submits that the Examiner fails to establish a *prima facie* case of anticipation of Claim 9 over Wensink. Wensink does not teach bonding of a DUT 22 via a surface mount attachment to a connector board 26 of decapsulation machine 10, as required by Claim 9.

Therefore, for at least the reasons described above, Applicant respectfully submits that Claim 9, as amended, is patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §102(b) rejection of Claim 9.

#### Claim 13

Claim 13, as amended, includes the following feature which is neither taught by either Wensink or the references of record:

receiving an IC package installed onto a first surface of a printed circuit board (PCB) via a surface mount attachment. [Emphasis added]

As indicated above, Wensink does not teach the receiving of an IC package bonded onto a first surface of a PCB via a surface mount attachment. As depicted in Wensink's FIG. 1, a DUT 22 is received which includes J-type leads 28. The J-type leads 28 enable connection of the DUT 22 to a connector board 26 of a decapsulation machine 10. However, instead of the DUT 22 to connector board 26 via bonding surface mounting, the J-type leads contact the connector board 26 by clamping DUT 22 to connector board 26 with clamps 24. In contrast, a surface mount attachment, as required by Claim 13, would require bonding of the J-type leads 28 to the connector board 26.

Therefore, Applicant respectfully submits that the Examiner fails to establish a *prima facie* anticipation of Claim 13 over Wensink. Consequently, for at least the reasons described above, Applicant respectfully submits that Claim 13, as amended, is patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §102(b) rejection of Claim 13.

#### Claims 16

Claim 16 depends from Claim 13 and, therefore, includes the patentable claim features of Claim 13, as described above. Accordingly, Claim 16 is patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §102(b) rejection of Claim 16.

#### **II. Claims Rejected Under 35 U.S.C. §103**

The Patent Office has rejected Claims 11 and 14 as being unpatentable over U.S. Patent No. 5,443,675 issued to Wensink ("Wensink") and applied to Claims 9, 13 and 16, and further in view of U.S. Patent No. 5,792,305 issued to Winsemius, et al. ("Winsemius"). Applicant respectfully traverses this rejection.

To establish a *prima facie* case of obviousness, the following criteria must be met: (1) there must be some suggestion or motivation to modify the reference or combine the reference teachings, (2) there must be a reasonable expectation of success, and (3) the prior art references must teach or suggest all the claim limitations. (MPEP §2142) For the reasons provided below, the Examiner has failed to establish a *prima facie* case of obviousness in view of the references of record.

Regarding Claim 11, Claim 11 depends from Claim 9 and therefore includes the patentable claim features as described above with reference to Claim 9. Applicant submits that the Examiner's citing of Winsemius fails to rectify the deficiency of Wensink's failure to teach testing of a DUT bonded to a PCB, as required by Claim 9. Consequently, for at least the reasons described above, Applicant respectfully submits that Claim 11 is patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 11.

Regarding Claim 14, Claim 14 depends from Claim 13 and therefore includes the patentable claim features as described above with reference to Claim 13. Applicant submits that the Examiner's citing of Winsemius fails to rectify the deficiency of Wensink's failure to teach

testing of a DUT bonded to a PCB via a surface mount attachment, as required by Claim 13. Consequently, for at least the reasons described above, Applicant respectfully submits that Claim 14 is patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 14.

The Patent Office has rejected Claims 10, 12 and 15 as being unpatentable over U.S. Patent No. 5,443,675 issued to Wensink ("Wensink") and applied to Claims 9, 13 and 16, and further in view of U.S. Patent No. 5,489,854 issued to Buck, et al. ("Buck"). Applicant respectfully traverses this rejection.

Regarding Claim 10, Claim 10 depends from Claim 9 and therefore includes the patentable claim features as described above with reference to Claim 9. Applicant submits that the Examiner's citing of Buck fails to rectify the deficiency of Wensink's failure to teach testing of a DUT bonded to a PCB, as required by Claim 9. Consequently, for at least the reasons described above, Applicant respectfully submits that Claim 10 is patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claim 10.

Regarding Claims 12 and 15, Claims 12 and 15 depend from Claim 13 and therefore includes the patentable claim features as described above with reference to Claim 13. Applicant submits that the Examiner's citing of Buck fails to rectify Wensink's failure to teach testing of a DUT bonded to a PCB via a surface mount attachment, as required by Claim 13. Consequently, for at least the reasons described above, Applicant respectfully submits that Claims 12 and 15 are patentable over the references of record. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the §103(a) rejection of Claims 12 and 15.



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**CONCLUSION**

In view of the foregoing, it is submitted that Claims 9-16, as amended, patentably define the subject invention over the cited references of record, and are in condition for allowance and such action is earnestly solicited at the earliest possible date. If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

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12400 Wilshire Boulevard  
Seventh Floor  
Los Angeles, California 90025  
(310) 207-3800

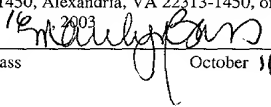
By: 

Joseph Lutz, Reg. No. 43,765

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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Non-Fee Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 16, 2003.

Marilyn Bass

  
October 16, 2003